

1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).----Ex Parte Obukowicz, 27 USPQ2d 1063, 1065 (PTO BA).

See also *In re Oetiker*, 24 USPQ2d 1443, 1444 for a review of the duty of the Examiner to establish a *prima facie* case of obviousness.

It is therefore respectively solicited that the Examiner withdraw the 35 U. S. C. 103 rejection ground upon reconsideration and allow the retained rejected claims.

SPECIFIC TRAVERSAL GROUNDS REGARDING THE REJECTED CLAIMS:

Claim 1:

Note particularly that the method of Claim 1 (Amended) defines the steps of piling the "flat storable sections of tire tread strips excluding sidewalls" into stacks "in compact rubber-to-rubber interfacing configurations" on pallets. Miller explicitly teaches away from this claimed feature in that Miller's tread-sidewall mats rather than applicant's claimed tire tread strips with sidewalls removed must be piled up and forced together in bales securing together the mats in an attempt to flatten the integral tread and sidewall mats, when stored on pallets. Thus Miller's baling bands are eliminated, a further unexpected non-obvious feature of applicant's claimed invention. It is factually shown in the Declaration and in the specific traversal grounds set forth hereinafter that only applicant's rejected methods, by going against Miller's explicit teachings, uniquely solve the mosquito breeding problem by avoiding accumulation of water by uniquely storing tire tread strips without sidewall structure cut from abandoned tire carcasses to obtain a water free configuration adapted to storage in the outside environment.

Claims 2, 9 (Amended), 10, 11, 13, and 15 dependent upon Claim 1 (Amended):

These rejected Claims are patentable along with patentable Claim 1 (Amended) preamble and also for defining more comprehensive methods. Thus, allowance upon reconsideration is respectfully solicited.

Claim 2:

Claim 2 establishes an efficient storage method of loading pallets with the *tire tread strips excluding sidewalls* of Claim 1 (Amended). Nothing in Miller or Pignataro, taken singly or together teaches applicant's unique and efficient, low cost method of loading pallets with large volumes of reclaimed tire parts in compact storage at bulk storage sites, as claimed. Thus, this claim adds further patentable merit to the method of parent Claim 1 (Amended).

Allowance upon reconsideration is therefore respectfully solicited.

Claim 9. (Amended):

The specific feature of piling the tire tread strips devoid of sidewalls into stacks that avoid accumulation of water when stored outside in the environment defines the solving of the mosquito breeding problem (acknowledged to be a problem by both references, but being solved uniquely by applicant). It is long recognized in 35 U. S. C. 103 case law that recognizing the solution of a significant unsolved problem long standing in the prior art cannot be 35 U. S. C. 103 obviousness. While both references recognize the problem, neither offers a solution, which is only made obvious by applicant's claimed method.

Accordingly, allowance of Claim 9 upon reconsideration is respectfully solicited.

Claim 10:

The feature of strapping the piles to the pallet is claimed here. Only Miller teaches palettizing the banded stacks of *integral tread and sidewall* mats (col. 7, lines 50-53), but there is no teaching of strapping the claimed piles of tire *tread strips without sidewalls* to the pallet as required to make the Examiner's required *prima-facie* rejection ground.

Thus this is a novel improvement in the transport and storage of bulk palleted loads of discarded tire carcasses, and allowance is respectfully solicited upon reconsideration.

Claim 11:

This claimed compact outdoor dump site configuration is illustrated in applicant's Fig. 5, and is not taught or suggested by either reference, taken singly or together. This claim is amended to improve its form under 35 USC 112 by properly separating and defining the two previously vaguely expressed method steps of transporting and storing.

Allowance of Claim 11 (Amended) as dependent upon allowance of parent Claim 1 further defining a novel compact storage configuration in the outdoor dump site is therefore respectfully solicited.

Claim 13:

In this claimed method, the flat treaded strips devoid of sidewalls are stacked on the pallets "without supporting bolts or hardware" which goes against the explicit teachings of Miller, not only in elimination of the sidewalls but also against Miller's

requirement (Fig. 4, col. 7, lines 46-50 that the mats be secured together by bands 42 or by pins 62 with enlarged heads 63 (Fig. 6, col. 8, lines 20-25).

Therefore, the Examiner's general inclusion of Claim 13 in the 35 U. S. C. 103 rejection ground has not established a prima facie ground of obviousness and allowance upon reconsideration is respectfully solicited.

Claim 14:

Claim 14 is cancelled to reduce issues.

Claim 15:

Claim 15 is patentable as dependent upon the parent Claim 1 (Amended) wherein the pallets are stored at an outside storage site, thus being in the presence of environmental moisture, whereas both references recognize but do not solve the mosquito breeding problem in tire carcasses stored at outside sites.

Accordingly it is respectfully solicited that this claim be allowed upon reconsideration.

Claim 17:

Claim 17 is amended in conformance with claim 1 (Amended) to positively set forth the further limitation of removing the sidewall portions, and thus is patentable for the same reasons set forth for Claim 1 (Amended) hereinbefore. This feature is explicitly forbidden by Miller and makes claim 17 (Amended) even more distinctive. Both references admit that mosquito breeding water is retained by tire carcasses stored in outside tire dumps, and neither reference teach the possibility of water proof storage at

such a site by applicant's claimed method.

Allowance upon reconsideration is therefore respectfully solicited.

Claim 24 (Amended):

Claim 24 (Amended) similarly to Claim 17 and Claim 1 (Amended), explicitly defining method steps going explicitly contrary to Miller's teachings and therefore ~~do not~~ establish that the Examiner has not set forth a prima-facie rejection ground to establish obviousness under 35 U. S. C. 103,. Applicant therefore uniquely excludes the sidewalls and stores tire tread strips taken from discarded tire carcasses in outdoor sites in a form that solves the mosquito breeding problem by avoiding accumulation of water in outdoor storage sites.

Thus this claim is patentably distinct for the reasons hereinbefore described and allowance upon reconsideration is respectfully solicited.

RE: THE DRAWING and AMENDED CLAIMS:

The formal drawing is appended along with the required clean copy of the amended claims.

IN THE CLAIMS:

Cancel claims 18-21, without prejudice.

3. (Amended) The environmentally safe method of storing and handling batches of rubber pieces salvaged from discarded tire carcasses in a bulk storage configuration obtained at low cost for compact storage of residual bulk rubber at bulk storage sites from

which bulk rubber may be reclaimed in due course for preparation of rubber products,
comprising in combination the steps of: cutting reclaimed tire carcasses into sets of
substantially flat storables sections of tire tread strips excluding sidewalls, preparing
pallets with loading platform areas of specified length and width dimensions for retaining
a plurality of stacks of said substantially flat sections in a storage configuration, [and]
stacking a plurality of the storables sections into said stacks in compact rubber-to-rubber
interfacing configurations with frictional resistance against movement of the sections
lateral to the pallet platform area thereby to facilitate transportation on said pallets for
storing and recalling the pallets from designated storage areas of confined space, [space,
The method of Claim 1 further comprising the steps of] cutting flat rectangular tread
strips from the carcasses of a length greater than the length or width dimension of the
platform areas and folding the flat strips into abutted stacked configurations having a
length footprint substantially that of one of the platform dimensions.

11. (Amended) The method of Claim 1 further comprising the steps of transporting
loaded pallets to store at [a] an outdoor storage dump site and storing the thus transported
pallets at the dump site in a compact configuration with pallets side-by-side and stacked
upon one another.

12.(Amended) The environmentally safe method of storing and handling batches
of rubber pieces salvaged from discarded tire carcasses in a bulk storage configuration
obtained at low cost for compact storage of residual bulk rubber at bulk storage sites from
which bulk rubber may be reclaimed in due course for preparation of rubber products,

comprising in combination the steps of: cutting reclaimed tire carcasses into sets of substantially flat storable sections of tire tread strips excluding sidewalls, preparing pallets with loading platform areas of specified length and width dimensions for retaining a plurality of stacks of said substantially flat sections in a storage configuration, stacking a plurality of the storable sections into said stacks in compact rubber-to-rubber interfacing configurations with frictional resistance against movement of the sections lateral to the pallet platform area thereby to facilitate transportation on said pallets for storing and recalling the pallets from designated storage areas of confined space. [The method of claim 1 further comprising the steps of] cutting the flat storable sections from the carcass tread of a length greater than one pallet dimension to be placed lengthwise along that pallet dimension and folding over said sections to interlock adjacent sections in the stacks by frictional rubber-to-rubber contact between the tread and two adjacent sections.

Cancel Claim 14.

16. (Amended) The environmentally safe method of storing and handling batches of rubber pieces salvaged from discarded tire carcasses in a bulk storage configuration obtained at low cost for compact storage of residual bulk rubber at bulk storage sites from which bulk rubber may be reclaimed in due course for preparation of rubber products, comprising in combination the steps of: cutting reclaimed tire carcasses into sets of substantially flat storable sections of tire tread strips excluding sidewalls, preparing pallets with loading platform areas of specified length and width dimensions for retaining a plurality of stacks of said substantially flat sections in a storage configuration, stacking

a plurality of the storable sections into said stacks in compact rubber-to-rubber interfacing configurations with frictional resistance against movement of the sections lateral to the pallet platform area thereby to facilitate transportation on said pallets for storing and recalling the pallets from designated storage areas of confined space. [The method of Claim 1 further comprising the more detailed steps of:] configuring the flat treaded strips longitudinal in shape to have a length compatible with folding and stacking the treaded strips aligned upon one of said length or width dimensions of said pallets in a folded U-shaped configuration, and stacking the interlocked flat treaded strips upon the pallets with the closed end of a plurality of the U-shaped configurations alternating near the opposite edges of the pallets.

17. (Amended) The environmentally safe method of converting discarded tire carcasses into reclaimable recycled bulk rubber in a configuration that precludes the accumulation of water when stored in an outside site comprising in combination the steps of cutting flat treaded strips exclusive of sidewall portions [of] having common widths from said carcasses in a longitudinal configuration, stacking the flat treaded strips into a compact stable self supporting rubber-to-rubber interfacing interlocked configuration precluding accumulation of water and resisting lateral movement of the strips upon a pallet loading platform adapted for transport by a fork lift truck, and transporting pallets carrying the interlocked treaded strips with fork lift trucks into said outside site.

SUMMARY:

Rejected Claims 1 (Amended), 2, 9 (Amended), 10, 11, 13, 15, 17 (Amended) and 24 (Amended) are retained for allowance upon reconsideration in view of the more persuasive arguments hereinbefore presented including the showing that the Examiner has not established a prima-facie case of obviousness under 35 U. S. C. case law. Each of these claims define novel subject matter that goes against the teachings of the primary Miller reference.

Allowable Claims 3-8, 12 and 16 are put into independent form and thus stand allowed. The additional fee of \$42.00 for one parent claim required in view of the cancellation of two original parent claims is enclosed..

Accordingly Claims 1-14, 15-17 and 24 are presented to put this application in condition for immediate allowance., which is respectfully solicited.

The formal drawing is enclosed.

The case has been put into proper form for immediate allowance.

Enc.

Declaration

Formal Drawings

Clean Copy of Amended Claims

Claim Fee Check \$42.00

Respectfully Submitted, Dec. 9, 2002

Laurence R. Brown
Laurence R. Brown, Counsel of Record

Amended Claims in Clean Copy Format

3. (Amended) The environmentally safe method of storing and handling batches of rubber pieces salvaged from discarded tire carcasses in a bulk storage configuration obtained at low cost for compact storage of residual bulk rubber at bulk storage sites from which bulk rubber may be reclaimed in due course for preparation of rubber products, comprising in combination the steps of: cutting reclaimed tire carcasses into sets of substantially flat storable sections of tire tread strips excluding sidewalls, preparing pallets with loading platform areas of specified length and width dimensions for retaining a plurality of stacks of said substantially flat sections in a storage configuration, and stacking a plurality of the storable sections into said stacks in compact rubber-to-rubber interfacing configurations with frictional resistance against movement of the sections lateral to the pallet platform area thereby to facilitate transportation on said pallets for storing and recalling the pallets from designated storage areas of confined space, cutting flat rectangular tread strips from the carcasses of a length greater than the length or width dimension of the platform areas and folding the flat strips into abutted stacked configurations having a length footprint substantially that of one of the platform dimensions.

11. (Amended) The method of Claim 1 further comprising the steps of transporting loaded pallets to store at an outdoor storage dump site and storing the thus transported pallets at the dump site in a compact configuration with pallets side-by-side and stacked upon one another.

12. (Amended) The environmentally safe method of storing and handling batches of rubber pieces salvaged from discarded tire carcasses in a bulk storage configuration obtained at low cost for compact storage of residual bulk rubber at bulk storage sites from which bulk rubber may be reclaimed in due course for preparation of rubber products, comprising in combination the steps of: cutting reclaimed tire carcasses into sets of substantially flat storable sections of tire tread strips excluding sidewalls, preparing pallets with loading platform areas of specified length and width dimensions for retaining a plurality of stacks of said substantially flat sections in a storage configuration, stacking a plurality of the storable sections into said stacks in compact rubber-to-rubber interfacing configurations with frictional resistance against movement of the sections lateral to the pallet platform area thereby to facilitate transportation on said pallets for storing and recalling the pallets from designated storage areas of confined space, cutting the flat storable sections from the carcass tread of a length greater than one pallet dimension to be placed lengthwise along that pallet dimension and folding over said sections to interlock adjacent sections in the stacks by frictional rubber-to-rubber contact between the tread and two adjacent sections.

16. (Amended) The environmentally safe method of storing and handling batches of rubber pieces salvaged from discarded tire carcasses in a bulk storage configuration obtained at low cost for compact storage of residual bulk rubber at bulk storage sites from which bulk rubber may be reclaimed in due course for preparation of rubber products, comprising in combination the steps of: cutting reclaimed tire carcasses into sets of

substantially flat storable sections of tire tread strips excluding sidewalls, preparing pallets with loading platform areas of specified length and width dimensions for retaining a plurality of stacks of said substantially flat sections in a storage configuration, stacking a plurality of the storable sections into said stacks in compact rubber-to-rubber interfacing configurations with frictional resistance against movement of the sections lateral to the pallet platform area thereby to facilitate transportation on said pallets for storing and recalling the pallets from designated storage areas of confined space, configuring the flat treaded strips longitudinal in shape to have a length compatible with folding and stacking the treaded strips aligned upon one of said length or width dimensions of said pallets in a folded U-shaped configuration, and stacking the interlocked flat treaded strips upon the pallets with the closed end of a plurality of the U-shaped configurations alternating near the opposite edges of the pallets.

17. (Amended) The environmentally safe method of converting discarded tire carcasses into reclaimable recycled bulk rubber in a configuration that precludes the accumulation of water when stored in an outside site comprising in combination the steps of cutting flat treaded strips exclusive of sidewall portions having common widths from said carcasses in a longitudinal configuration, stacking the flat treaded strips into a compact stable self supporting rubber-to-rubber interfacing interlocked configuration precluding accumulation of water and resisting lateral movement of the strips upon a pallet loading platform adapted for transport by a fork lift truck, and transporting pallets carrying the interlocked treaded strips with fork lift trucks into said outside site.